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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,122	10/20/2003	Jay V. Clark	1165.54USC4	3630

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EXAMINER	
CHENG, JOE H	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No.	Applicant(s)	
	10/690,122	CLART ET AL	
	Examiner	Art Unit	
	Joe H. Cheng	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2003 and 17 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/20/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the Preliminary Amendments filed on October 20, 3002 and May 17, 2004, claims 1-40 have been cancelled, and the newly added claims 41-46 are pending.

Specification

2. The disclosure is objected to because of the following informalities: The term "This is a continuation of application Serial No. 10/425,775, filed April 29, 2003, which is a continuation of application Serial No. 09/660,204, filed September 12, 2000, now U.S. Patent No. 6,558,161 B1, which is a continuation of application Serial No. 09/141,804, filed on August 28, 1998, now U.S. Patent No. 6,168,440 B1, which is a continuation of application Serial No. 09/003,979, filed on January 7, 1998, now abandoned, which is a continuation of application Serial No. 08/561,081, filed November 20, 1995, now U.S. Patent No. 5,735,694, which is a continuation of application Serial No. 08/290,014, filed August 12, 1994, now U.S. Patent No. 5,558,521, which is a division of application Serial No., 08/014,176, filed February 5, 1993, now U.S. Patent 5,437,554. U.S. Patent No. 5,690,497, U.S. Patent No. 5,458,493, U.S. Patent No. 6,155,839, U.S. Patent No. 6,183,261, U.S. Patent No. 6,168,440, U.S. Patent No. 5,735,694, U.S. Patent No. 5,466,159, U.S. Patent No. 5,437,554, and U.S. Patent No. 6,558,166 B1 are hereby incorporated by reference in their entirety." should be recited as --This is a continuation of application Serial No. 10/425,775, filed April 29, 2003, now U.S. Patent No. 6,749,435 B2, which is a continuation of application Serial No. 09/660,204, filed September 12, 2000, now U.S. Patent No. 6,558,161 B1, which is a continuation of application Serial No. 09/141,804, filed on August 28, 1998, now U.S. Patent No. 6,168,440 B1, which is a continuation of application

Serial No. 09/003,979, filed on January 7, 1998, now abandoned, which is a continuation of application Serial No. 08/561,081, filed November 20, 1995, now U.S. Patent No. 5,735,694, which is a continuation of application Serial No. 08/290,014, filed August 12, 1994, now U.S. Patent No. 5,558,521, which is a division of application Serial No., 08/014,176, filed February 5, 1993, now U.S. Patent 5,437,554. U.S. Patent No. 5,690,497, U.S. Patent No. 5,458,493, U.S. Patent No. 6,155,839, U.S. Patent No. 6,183,261, U.S. Patent No. 6,168,440 B1, U.S. Patent No. 5,735,694, U.S. Patent No. 5,466,159, U.S. Patent No. 5,437,554, U.S. Patent No. 5,558,521, and U.S. Patent No. 6,558,166 B1 are hereby incorporated by reference in their entirety.--, so as to clarify the status. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 42-44 and 46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "configured to a plurality of data items" (line 4 of claim 43), "configured to selectively the data item" (line 8 of claim 43) and "configured to automatically selectively to the evaluator" (line 10 of claim 43) should be respectively recited as --configured to receive a plurality of data items--, --configured to selectively present the data item-- and --configured to automatically selectively present to the evaluator--, so as to clarify the confusion. Further, the antecedent basis for "the corresponding evaluation rules" (as per claims 42, 44 and 46) has not been clearly set forth.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Double Patenting

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 41-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,155,839 (hereinafter as Clark et al'839) or claims 1 and 2 of U.S. Patent No. 5,690,497 (hereinafter as Clark et al'497). Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the patented claims and the proposed application claims are minor, obvious and board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of "***evaluation rules***", "***data items***" (as per claims 41-36), "***evaluators***", "***evaluating data items***" (as per claims 41, 43 and 45), "receiving a plurality of ***data items over a distributed computer network***", "storing a plurality of ***evaluation rules***, each of the ***evaluation rules*** relating to a procedure for ***evaluation*** at least a particular one of the ***data items***", "selectively presenting the ***data item to an evaluator over a distributed computer network***", "automatically selectively presenting to the ***evaluator the evaluation rules related to the data item*** presented to the ***evaluator over a distributed computer network***" (as per claim 41), "***a receiving subsystem configured*** to a plurality of ***data items over a distributed computer network***", "***a storing subsystem configured*** to store a plurality of ***evaluation rules***, each of the ***evaluation rules*** relating to a procedure for ***evaluation*** at least a

particular one of the ***data items***", "***a presentation subsystem configured*** to selectively the ***data item to an evaluator over a distributed computer network***", "***a selection subsystem configured*** to automatically selectively to the ***evaluator the evaluation rules related to the data item*** presented to the ***evaluator over a distributed computer network***" (as per claim 43), "receiving a plurality of ***data items over a distributed computer network***", "storing a plurality of ***evaluation rules***, each of the ***evaluation rules*** relating to a procedure for ***evaluating*** at least a particular one of the ***data items***", "selectively presenting the ***data item to an evaluator over a distributed computer network***" and "automatically selectively presenting to the ***evaluator the evaluation rules related to the data item*** presented to the ***evaluator over a distributed computer network***" (as per claim 45) are the obvious alternative languages since these merely describe the "***scoring rules***", "***test items*** or ***test answers***" (claims 1-8 of Clark et al'839 or claims 1 and 2 of Clark et al'497), "***test resolvers***", "***scoring test items***", "receiving a plurality of ***answers for test questions***", "storing a plurality of ***scoring rules***, each of the ***scoring rules*** relating to a procedure for ***scoring*** at least a particular one of the ***test questions***", "selectively presenting the ***test answers to a test resolver***", "automatically selectively presenting to the ***test resolver the scoring rules related to the test question corresponding to the answer*** presented to the ***test resolver***" (claim 1 of Clark et al'839) or "receiving a plurality of ***answers for test questions, the answers each comprising an electronic representation of at least a portion of a test answer sheet***", "storing a plurality of ***scoring rules***, each of the ***scoring rules*** relating to a procedure for ***scoring*** at least a particular one of the ***test questions***", "selectively presenting the ***test answers to a test resolver***", "automatically selectively presenting to the ***test resolver the scoring rules related to the test question corresponding to the answer*** presented to the ***test resolver***" (claim 1 of Clark et

al'497), "***receiving means for electronically receiving*** or ***a receiving subsystem configured to receive*** a plurality of ***answer for test questions***", "***storage means for electronically storing*** or ***a storing subsystem configured to store*** a plurality of ***scoring rules***, each of the ***scoring rules*** relating to a procedure for ***scoring*** at least a particular one of the ***test questions***", "***display means for selectively presenting*** or ***a presentation subsystem configured*** to selectively ***present*** the ***test answer to a test resolver***", "***rules means for*** or ***a selection subsystem configured*** to automatically selectively ***present*** to the ***test resolver the scoring rules related to the test question*** presented to the ***test resolver***" (claim 3 or 5 of Clark et al'839), "receiving a plurality of ***answer for test questions***", "storing a plurality of ***scoring rules***, each of the ***scoring rules*** relating to a procedure for ***scoring*** at least a particular one of the ***test questions***", "selectively presenting the ***test answer to a test resolver***" and "automatically selectively presenting to the ***test resolver the scoring rules related to the answer*** presented to the ***test resolver***" (claim 7 of Clark et al'839) respectively in boarder terms and the differences are the use of alternate terminology which are obvious and do not change the scope of the proposed claims. Hence, the instant claim does not differ from the scope of the patented claims 1-8 of Clark et al'839 or claims 1 and 2 of Clark et al'497. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sachs (U.S. Pat. No. 3,981,087) - note Figs. 1-14;

Harris et al (U.S. Pat. No. 5,228,116) - note Figs. 1-20;

Goodridge et al (U.S. Pat. No. 5,848,393) - note Figs. 1-5.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571)272-4433. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
Primary Examiner
Art Unit 3713

Joe H. Cheng
March 1, 2005